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Masakuni Noda

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01/29/2009

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EXAMINER

NGUYEN, QUANG

ART UNIT

PAPER NUMBER

1633

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



### DETAILED ACTION

***This application was transferred to Examiner Quang Nguyen, Ph.D. in AU 1633.***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/29/08 has been entered.

Amended claims 1, 6 and 12-37 are pending in the present application. Claims 12-37 were withdrawn previously because they are directed to non-elected inventions; and they should be cancelled. **Please note that a complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.**

In light of currently amended claims 1 and 6, the following species restriction is required.

### ***Species Election/Restrictions***

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

**A screening method comprising the step of selecting a compound that decreases the level of at least one gene product recited in the Markush group of independent claim 1.**

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

Claim 1 is directed to a method of screening for a therapeutic substance for a renal disease comprising **the step of selecting a compound that decreases the level of at least one selected from urinary albumin excretion, TGF- $\beta$ 1, ICAM-1, tissue factor, PDGF-B, fibronectin and  $\alpha$ 1(I) collagen.**

The following claim(s) are generic: claims 1 and 6.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

Each of the recited gene products is structurally and regulated differently at various degrees one from the others, particularly under a specific condition; and therefore each of the compounds to be selected has different properties depending on

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which recited gene product(s) and/or which extent or degree of a decreased level for anyone of the recited gene products are chosen under a particular condition.

Selecting a compound with a particular set of properties as set forth in the preceding paragraph can be considered to be a "special technical feature"; and therefore the listed species lack the same or corresponding special technical features.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang Nguyen, Ph.D., whose telephone number is (571) 272-0776.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Joseph T. Voitach, Ph.D., may be reached at (571) 272-0739.

**To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1633; Central Fax No. (571) 273-8300.**

**Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.**

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

/QUANG NGUYEN/

Primary Examiner, Art Unit 1633